UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/884,153 | 06/19/2001 | Steven B. Adler | AUS920010588US1 | 3514 |

| 50170 | 7590 | 06/01/2005 |
|---|---|---|

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| EXAMINER |
|---|
| HO, THOMAS M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2134 | |

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No.<br>09/884,153 | Applicant(s)<br>ADLER ET AL. |
|---|---|---|
| | Examiner<br>Thomas M. Ho | Art Unit<br>2134 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _07 December 2004_.

2a)☒ This action is **FINAL**.  2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-9_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-9_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _6/19/01_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

## DETAILED ACTION

1.      The amendment of 12/7/04 has been received and entered.

2.      Claims 1-9 are pending.

### *Response to Arguments*

3.      Applicant's arguments have been fully considered but they are unpersuasive.

Applicant has argued the following (page 5, paragraph 3 – page 6, paragraph 2):

*Returning to rejected Claim 1, concerning constructing a rule for each circumstance in which*

*one of said privacy-related actions may be taken or must be taken." the Examiner cites a portion*

*of Kido that merely states: "In the field of highly secured information processing, such as an*

*accounting calculation or an electronic commerce, it has been strongly desired to provide an*

*assurance of credibility of rule sets and data that are embedded into business objects (or classes)*

*for use in such information processing." Kido. Col. 1, Lines 15-20. Apparently Kido is*

*describing impersonal "data that are frequently changed to reflect day-to-day transactions,*

*including currency exchange rates and accounting rules." See Kido. Col. 1, Lines 23-26.*

*The Office action at Page 3 mistakenly asserts that Kido describes "personally identifiable*

*information" in a section describing a digital signature. The Office action cites a description of a*

*digital signature to confirm that the data is not corrupted." Kido, Col. 12, Lines 1-15. Again,*

*Kido is describing impersonal data such as currency exchange rates. Kido teaches nothing about*

*"personally identifiable information" or personal privacy. Kido's text contains none of the*

*following terms: "personally identifiable information," "personal information,"*

*"privacy-related action " "privacy," or "private."*

Column 15, lines 6-13) of Kido recites that access to the execution object is given. Kido

previously discloses details of the execution object in figure 3 which discloses the details of a

provider certificate, identifier, public key, and electronic signature. The Examiner contends that

these information explicitly recite information that may be construed as "personally identifiable

information", as from this information, one can derive the party involved in the object

transaction.

Further attention is directed towards the Applicant's characterization of the term

"privacy-related action."

*The rules model is based on a limited set of privacy-related actions: access, disclose, release,*

*notify, utilize, update, withdraw consent, give consent, delete, anonymize, depersonalize, and*

*repersonalize. (Specification, page 4, line 9-13 et seq.)*

Kido (Column 15, lines 1 –15) explicitly recites that access to the execution object may be given.

In light of the specification, the Examiner has interpreted such action to be a "privacy related

action" "If this execution object is determined to be valid, access thereto is

allowed/implemented..."

Applicant further argues:

*(Page 6, last paragraph – page 7, first paragraph)*

*Concerning the above quoted language of rejected Claims 2 and 3, the Office action cites a*

*section of Kido that merely describes: "(a) receiving from an application an object access*

*request including object specifying information; (b) accessing the first object stored in said first*

*storage means based on said first path information "Kido Col. 5, lines 13-15. The Office action*

*at Pages 3-4 assumes the existence of a hypothetical error message "suggesting what must be*

*done" to have a request approved, or specifying "at least one additional action that must be*

*taken." However, no such error message is described in Kido.*

The Examiner contends that Kido does in fact describe an error message, and that such error

message is not assumed. Claim 2, is specifically directed to aspects of the output originally

recited in claim 1, which claim 2 depends upon. In the rejection of claim 1, however, the

Examiner recited (Column 15, lines 7-13) in reference to the provided output regarding the

allowance of access to a particular object.

Kido (Column 15, lines 7-13) clearly recites the error message should the access to the object not

be properly authorized.

"If this execution object is determined to be valid, access thereto is allowed/implemented, and

then the present procedure is terminated. Conversely a test at anyone of the blocks....results in a

negative determination, an error message is transmitted to the stub object..."

## *Claim Rejections - 35 USC § 102*

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kido et al., US patent

6,471,068.

In reference to claim 1:

Kido et al. discloses a method of handling personally identifiable information, said method

comprising:

- Defining a limited number of privacy-related actions regarding said personally identifiable information, where the privacy-related action is access to authorized information or methods. (Column 15, lines 6-13)

- Constructing a rule for each circumstance in which one of said privacy-related actions may be taken or must be taken (Column 1, lines 15-20), where the rule set is access for information processing.

- Allowing for the input of dynamic contextual information to precisely specify the condition for evaluation of said rule, where the input of dynamic contextual information is the issuance of a certificate. (Column 11, lines 55-67)

- Creating a programming object containing at least one of said rules, where the object contains management information regarding its usage noted as rules. (Column 1, lines 15-20) (Column 2, lines 35-54)

- Associating said programming object with said personally identifiable information, where the programming object is associated with a personally identifiable digital certificate and signature. (Column 12, lines 1-15)

- Processing a request (Column 5, lines 13-15)

- Providing an output, where the output is the authorization through access allowance. (Column 15, lines 7-13)


In reference to claim 2:

Kido et al. discloses the method of claim 1, wherein said output is selected from the group consisting of

- Authorizing said privacy-related action  (Column 5, lines 13-15)

- Authorizing said privacy-related action, plus specifying one or more tasks, where the one

  or more tasks is access or implementation  (Column 5, lines 13-15)

- And denying said request but also suggesting what must be done to have said request

  approved, where the request is denied and the suggestion of what must be done to have

  request approved is an error message.  (Column 5, lines 13-15)


In reference to claim 3:

Kido et al. discloses the method of claim 1, (Column 5, lines 13-15) wherein said output includes

the specification of at least one additional action that must be taken, where the error message

specifies the reason why a request was denied and what must be taken to rectify it.


Claims 4, 7 are rejected for the same reasons as claim 1.

Claims 5, 8 are rejected for the same reasons as claim 2.

Claims 6, 9 are rejected for the same reasons as claim 3.


*Conclusion*

6.      THIS ACTION IS MADE FINAL.  Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action.  In the event a first reply is filed within TWO

MONTHS of the mailing date of the final action and the advisory action is not mailed under after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension pursuant to 37 CFR

1.136(A) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

7.      Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas M Ho whose telephone number is (703)305-8029. The

examiner can normally be reached on M-F from 8:30am – 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gregory A. Morse can be reached at (703)308-4789. The fax phone numbers for the

organization where this application or proceeding is assigned are (703)746-7239 for regular

communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703)306-5484.

TMH

May 9th, 2005

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100